

The B value in the present and former claims is known to those skilled in the art. The Examiner specifically asked what is a value B. See, Office Action page 3, paragraph no. 7, sub-paragraph b. Applicants submit that their specification is directed to those who are skilled in the art and that such persons will be instructed that the bending rigidity value B per unit length can be calculated in accordance with the disclosed formula. The Examiner should carefully review the present specification, including page 14, lines 11-17. Those skilled in the art know what the value B is, and they know how it is calculated.

In short, KES and B are known parameters, it is known how they are determined, and the metes and bounds of the claims are reasonably definite as called for by the statute. Nothing more is required.

The Examiner objected to the specification under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide an adequate written description of the invention. Applicants' submit that the objection should be reconsidered and withdrawn. The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. In re Buchner, 929 F.2d 660, 661, 18 USPQ 2nd 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Anti-bodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert., denied 480 U.S. 947 (1987); and Lindemann Maschinen Fabrik GMBH v. American Hoist & Derric Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). This is the basic standard that should be applied. See the U.S. Department of Commerce Publication "35 U.S.C. § 112, first paragraph, Enablement Training Manual" (August 1996) at page 15.

Most often, additional factors, such as the teachings in pertinent references, will be available to substantiate that a specification provides enablement. See, In re Marzocchi, 439 F.2d 220, 223-224, 169 USPQ 367, 368-70 (CCPA 1971). It is consistent with the foregoing

principals that applicants' call attention to the following: As the Court stated in In re Enyde, 480 F.2d 1364, 1370 (CCPA 1973) while reversing an enablement rejection:

"A patent applicant may offer ... patents and publications, to show the knowledge possessed by those skilled in the art and thereby establish that a given specification disclosure is enabling."

The Court made the same point in In re Strahilevitz, 668 F.2d 1229, 1232 (CCPA 1982) while reversing an enablement rejection:

"Appellant explains that his invention resides in combining the known prior art techniques of hemodialysis or hemoperfusion with immunochemical dialysis and immunochemical adsorption. He properly relies on literature citations to establish both the level of ordinary skill in the art and the fact that techniques necessary to practice his invention were known in the art."

Accord, Martin v. Johnson, 454 F.2d 746, 751 (CCPA 1972) (applicant cited German and U.S. patents to show enablement.)

Applicants therefore respectfully direct the Examiner's attention to U.S. Patent No. 6,074,964 and specifically to column 4 therein which it specifically teaches those skilled in the art:

In the present invention, the KES (Kawabata Evaluation System) measurement is, as disclosed in Vol. 26, No. 10, P721-P728 (1973), Magazine of Textile Machinery Society (Textile Engineering) written by Sueo Kawabata, measurement of resiliency at each curvature realize when the fabric is bent by using the KES bending rigidity measuring machines (manufactured by KATO TECH). An assumption is made that the average value of the resiliency from a curvature of 0.5 to a curvature of 1.5 is B (unit: g.cm²/cm). Moreover, the foregoing measurement is performed in both the longitudinal and lateral directions of the fabric and an assumption is made that the average value is B. Then, [the] ratio B/W of the foregoing value B and weight W (unit: g/m²) of the fabric is obtained.

U.S. Patent No. 6,074,964, column 4, lines 14-27, copy attached.

The just-cited U.S. Patent does refer to an article, "Kawabata, Characterization Method of the Physical Property [sic] of Fabrics and the Measuring System for Hand-

Feeling Evaluation, Magazine of Textile Machinery Society" (Textile Engineering) Vol. 26, No. 10, pages 721-728 (1973), copy attached.

A simple Internet search for Kawabata Evaluation System demonstrates its availability to those skilled in the art. The search found about **720** citations for Kawabata Evaluation System, see the attached.

Based on the original specification, and the materials just mentioned it should be apparent that the specification as filed, without Amendment, contains a written description of the inventions, and of the manner and process of making and using them, in such full, clear, concise and exact terms as to enable any persons skilled in the art to which they pertain, or with which they are most nearly connected, to make and use the same.

Therefore, the objection to the specification should be reconsidered and withdrawn.

The specification at page 12, line 33 refers to a pure bending characteristic testing device, i.e. "tester". The tester is identified as the JTC-1 device manufactured by Nihon Seiki Seisakusho Co., Ltd. Therefore, there is no foreign test standard cited in the specification at page 12, line 33. Accordingly, the objection to the specification as noted in the Office Action at page 2, in paragraph No. 4 should be reconsidered and withdrawn.

The anticipation rejection under 35 U.S.C. § 102(e) over Kawatsu et al., U.S. Patent No. 6,025,286 should likewise be reconsidered and withdrawn. According to the Office Action, the reference is said to describe a heat-sensitive stencil sheet that comprises a fiber support of polyester fibers and a polyester film laminated on the fiber support. The Office Action further characterized the reference as disclosing that an adhesive may be used for laminating the fiber support in the polyester film, citing to the abstract, background art in claim 1. The Examiner concluded that "since the prior art uses the same materials as the current invention, the prior art's invention possesses the claimed properties (i.e. stencil

strength, a value of T-H greater than or equal to 0.150)." Office Action, again, at page 4, paragraph no. 9.

The Examiner's thesis appears to rest on an alleged "inherency." In order to sustain any alleged inherent anticipation, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. See, e.g. In re King, 801 F.2d 1324 (Fed. Cir. 1986); In re Oelrich, 666 F.2d 578, (CCPA 1978); Hansgirk v. Kemmer, 102 F.2d 212 (CCPA 1940); and Ex parte Levy, 17 USQP2d 1461 (Bd. Pat. App. Int. 1990).

"Inherent" means "certain." According to the Federal Circuit the so-called inherency doctrine means that

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled... [such] that the missing...matter is necessarily present in the... reference, and that it would be so recognized by persons of ordinary skill... '... inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient...'".

Continental Can Co. USA, Inc. v Monsanto Co., 948 F.2d 1264, 1268-69, (Fed. Cir. 1991) (citations omitted) (emphasis added). In the earlier decision of In re Oelrich, 666 F.2d at 581-2, the Court held:

"The mere fact that a certain thing may result from a given set of circumstances is not sufficient (to establish inherency) ... (which requires that) the disclosure is sufficient to show the natural result flowing from the operation as taught would result in the performance of the questioned function..."

As those skilled in the art recognize both from their experience and from the present specification, even if stencil sheets satisfy a conventional requirement as to stencil strength and rigidity (sometimes called nerve), the stencil sheets are often times jammed or become creased in a printing machine. These problems have plagued the art. Is in view of those

problems that the present claimed inventors discovered that using a stencil sheet satisfying the residual torque values and the bending rigidity value B, that the problems can be largely ameliorated, if not eliminated. This is clearly disclosed to those skilled in the art in the present specification at, for instance, page 2 starting at line 8.

The values just mentioned are not linked with the conventionally used printers for the tensile strength. This is amply demonstrated by the results reported in the present specification and attention is respectfully directed to Table 1 at page 20.

Furthermore, the cited '286 patent to Kawatsu et al. acknowledges a number of problems associated with conventional heat-sensitive stencil sheets. The reference describes of these problems at column 1, lines 28 through column 2, line 4. The ensuing description of the Kawatsu et al. solution to these problems focuses on a heat-sensitive stencil sheet having an orientation parameter (R1) and an orientation parameter (R2) of the fiber respectively obtained by laser Raman Spectrometry in a range from 3 to 10. '286 patent, column 2, see Summary of the Invention. The values associated with the parameters would not have suggested the applicants' differing solution to the problem. The Applicants' different approach is neither literally nor inherently within the four corners of the '286 patent to Kawatsu et al. Therefore, the present claimed inventions would not have been obvious, in view of the reference, and they are certainly novel over it.

This case has earned a Notice of Allowance, and notice to that effect is earnestly but respectfully solicited.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 

Kendrew H. Colton

Reg. No. 30,368

Tel. No.: (202) 861-3606

Fax No.: (202) 822-0944

KHC/stg
1100 New York Avenue, N.W.
Ninth Floor
Washington, D.C. 20005-3918
(202) 861-3000